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EXAMINER

OSMAN, RAMY M

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/769,514	Applicant(s) MONDRAGON, OSCAR	
	Examiner Ramy M. Osman	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Claims

1. This communication is in response to amendment filed on May 18, 2005, where applicant amended claims 1-8 and added new claims 9-15. Claims 1-15 are pending.

Specification

2. The disclosure is objected to because of the following informalities:
On page 2, paragraph 0005, line 7, change "menas" to means".
On page 3, paragraph 0010, line 2, change "providing" to "provided".
Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Applicants amendments overcome the previous 112 second paragraph rejections, and they are therefore withdrawn. However:
5. Claim 8 recites the limitation "said personal information" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-4 and 9-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Alles et al (US Patent No 6,425,010) in view of Krishan et al (US Patent No 6,442,529).**

8. In reference to claims 1 and 15, Alles in view of Krishan teaches a method for advertising through the Internet (Abstract), comprising:

(a) providing a user with access to a service provider server through the internet (column 1 lines 27-35);

(b) providing said user a menu of internet applications available on the server (column 1 lines 33-37, column 1 line 65 – column 2 line 5 and column 2 lines 13-25 & 55-65, Alles discloses a set of applications on a server that provides services of a sponsor);

(c) providing said user a menu of free services that are available on the server (column 1 lines 31-33, Alles discloses free access to the Internet via an ISP server);

(d) providing said user a menu of sponsors of the said free services on the server (column 2 lines 5-25, Alles discloses providing sponsor information to the user);

(e) receiving information from the user on a selected internet application that said user desires to use (column 1 lines 27-41 and column 1 line 65 – column 2 line 5, Alles discloses user inherently selecting one of the various services provided to it by the sponsor);

(f) receiving information from the user on a selected sponsor that offers a free service that is available on the server (column 2 lines 5-35); and

(g) providing said user with access to use said free service of said selected sponsor (column 1 lines 27-41);

Alles fails to explicitly teach the limitation of “wherein said internet application selected by said user takes on a look and feel of the selected sponsor of the free service; wherein said look and feel comprises a skin”.

However, “Official Notice” is taken that the feature of Internet applications taking on a look and feel of a selected sponsor of the free service is old and well-known in the art as is disclosed by Krishan. Krishan teaches advertisers displaying their advertisements through display software. The purpose of this is for the advertisers to subsidize Internet access fees for users via an Internet Service Provider. (Krishan, Summary, column 6 lines 49-65 and column 7 lines 5-50).

It would have been obvious for one of ordinary skill in the art to modify Alles by making the Internet applications taking on a look and feel of a selected sponsor of the free service as taught by the applicants admitted prior art. One would be motivated to do so to generate customers visiting both the service providers and the sponsors pages.

9. In reference to claim 2, Alles in view of Krishan teaches the method of claim 1, wherein said free service comprises a predetermined amount of data storage space on a hard disk of the service provider. “Official notice” is taken that Internet service providers like Yahoo, MSN (Hotmail), AOL, and others, inherently provide storage in the form of email, web space, etc., as is disclosed by Krishan (column 1 lines 50-65). Therefore it would have been obvious for one of

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ordinary skill in the art to make the ISP of Alles also provide storage because that is a service that all ISP's provide.

10. In reference to claim 3, Alles teaches the method of claim 1, wherein said free service comprises access time to the internet (column 1 lines 31-33).

11. In reference to claim 4, Alles in view of Krishan teaches the method of claim 1, wherein said application comprises any of: e-mail, a calendar, an instant messaging application, and a chat room. "Official notice" is taken that applications like e-mail, calendars, instant messaging and chat rooms are well known in the art and are commonly offered by ISP's like Yahoo, MSN (Hotmail), AOL, and others as is disclosed by Krishan (column 1 lines 50-65). Therefore, it would have been obvious for one of ordinary skill in the art to make the ISP of Alles also provide e-mail, calendars, instant messaging and chat rooms because that is a service that all ISP's provide.

12. In reference to claim 9, Alles in view of Krishan teaches the method of claim 1, further comprising the step of: a user choosing a combination of any of: hard disk space, an email service, a calendar, and access time to the internet; wherein said combination comprises said information from the user on a selected internet application that user desires to use (Krishan, column 1 lines 50-65).

13. In reference to claim 10, Alles in view of Krishan teaches the method of claim 1, further comprising the step of: displaying a logo of said sponsor (Krishan, column 11 lines 9-15 & 38-45 and column 14 lines 10-23).

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14. In reference to claim 11, Alles in view of Krishan teaches the method of claim 1, further comprising the step of: displaying a trademark of said sponsor (Krishan, column 11 lines 9-15 & 38-45 and column 14 lines 10-23, a logo can inherently comprise a trademark).

15. In reference to claim 12, Alles in view of Krishan teaches the method of claim 1, further comprising the step of: displaying a combination of colors associated with said sponsor (Krishan, column 11 lines 9-15 & 38-45 and column 14 lines 10-23, a logo inherently comprises a combination of colors).

16. In reference to claim 13, Alles in view of Krishan teaches the method of claim 1, further comprising the step of: displaying a logo of said sponsor; displaying a trademark of said sponsor; and displaying a combination of colors associated with said sponsor (Krishan, column 11 lines 9-15 & 38-45 and column 14 lines 10-23).

17. In reference to claim 14, Alles in view of Krishan teaches the method of claim 1, wherein said skin comprises any of:

An appearance of a button; a background image; a border; a color of a graphic element; a window frame; a scroll bar; a button; and a shape of a browser window (Krishan, column 11 lines 9-15 & 38-45 and column 14 lines 10-23).

18. Claims 5-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Alles et al (US Patent No 6,425,010) in further view of Urera (US Patent Publication No 2002/0078059).

19. In reference to claims 5 and 6, Alles teaches the method of claim 1. Alles fails to explicitly teach wherein step (e) further includes receiving personal data from said user in

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addition to said selection information; and wherein the personal information provided by said user includes the name, address, country and e-mail address of said user. However, Urera teaches providing Internet access and tracking user access. Urera discloses receiving personal data from said user in addition to said selection information; and wherein the personal information provided by said user includes the name, address, country and e-mail address of said user (paragraphs [0030 and 0035]).

It would have been obvious for one of ordinary skill in the art to modify Alles by receiving personal data from said user in addition to said selection information; and wherein the personal information provided by said user includes the name, address, country and e-mail address of said user as per the teachings of Urera so that user Internet access can be tracked.

20. In reference to claim 7, Alles in view of Urera teach the method of claim 5. Alles fails to teach wherein the personal information provided by the user is maintained in a database. However, Urera teaches providing Internet access and tracking user access. Urera discloses wherein the personal information provided by the user is maintained in a database (paragraphs [0007,0021 and 0035]).

It would have been obvious for one of ordinary skill in the art to modify Alles by making the personal information provided by the user is maintained in a database as per the teachings of Urera so that user Internet access can be tracked and stored in a database.

21. In reference to claim 8, Alles in view of Urera teach the method of claim 7. Alles fails to explicitly teach wherein said personal information provided by said user is used for conducting surveys, for conducting segmented marketing or for sending banners to selected users. However, Urera teaches providing Internet access and tracking user access. Urera discloses wherein said

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personal information provided by said user is used for conducting surveys, for conducting segmented marketing or for sending banners to selected users (Abstract and paragraphs [0035 and 0048]).

It would have been obvious for one of ordinary skill in the art to modify Alles by making said personal information provided by said user is used for conducting surveys, for conducting segmented marketing or for sending banners to selected users as per the teachings of Urera so that user Internet access can be tracked for advertising purposes.

Response to Arguments

22. Applicant's arguments with respect to claims 1-15 have been considered but are not persuasive.

23. Applicant argues that the look and feel of a sponsor display is distinct from a banner advertisement.


In reply, the claims are broad and are broadly interpreted. The claims fail to detail anything further beyond the look and feel of a sponsor. A banner advertisement of a sponsor inherently has the look and feel of that sponsor and subsequently its own skin. A sponsor display is the same as a sponsor banner. This interpretation is applicable because the applicant has failed to mention any element of an interface that the skin may be applied to. Therefore the claims are open-ended and are thus interpreted broadly to mean the application showing a sponsor banner, where the banner has its own inherent look and feel, and therefore the application takes on the look and feel of the sponsor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMO
August 7, 2005


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